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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,351	08/07/2007	Luca Matteucci	78857.105418	2949
86528	7590	05/26/2010		
King & Spalding LLP 401 Congress Avenue Suite 3200 Austin, TX 78701			EXAMINER JONAITIS, JUSTIN M	
			ART UNIT 3752	PAPER NUMBER
			NOTIFICATION DATE 05/26/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

AustinUSPTO@kslaw.com
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Office Action Summary	Application No. 10/598,351	Applicant(s) MATTEUCCI ET AL.	
	Examiner JUSTIN JONAITIS	Art Unit 3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/05/2010 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2, 4-6, 8-10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically applicant states that the second part of the needle is joined to a coupling unit, however it appears the coupling unit is the assembly of components as a whole and instead the second part of the needle is joined to the coupling body (of the coupling unit). For examination purposes examiner will examine the claims as such.

Further the independent claims all state (in similar terms), "such that keeper fits substantially tightly within the recess to substantially prevent any radial movement of the keeper and the needle relative to the needle. It's unclear exactly what applicant is trying to claim here, for examination purposes examiner assumes applicant means that the keeper first substantially tightly within the recess to substantially prevent any radial movement of the keeper and first needle part relative to the second needle part.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

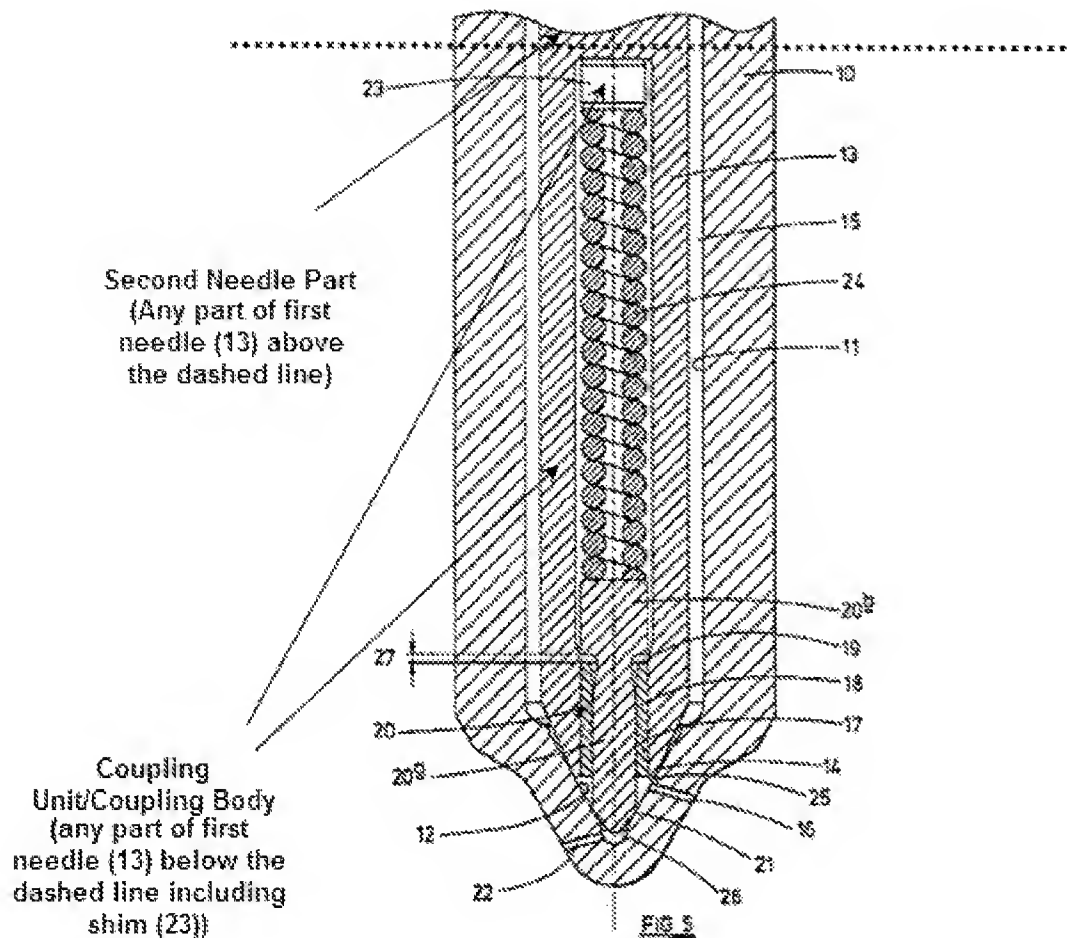
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 5-6, & 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent #6,260,775 to Lambert et al.

The figure below is reproduced from the Lambert reference in order to show examiner's interpretation.



U.S. Patent # 6,260,775 to Lambert et al. : Figure 5

In re claims 1-2, 5-6, and 9, Lambert discloses a fluid injector comprising an actuator unit (column 6, lines 24-33 disclose an actuator), a cartridge (nozzle body (10)) comprising a recess (bore (11)) which on one of its open ends forms an injection nozzle (outlet opening (22)) forms the injection nozzle).

The device disclosed by Lambert further includes a needle comprising a first and second part (second needle (20) and portion of first needle (13) above the dashed line in figure 5 above respectively) with the first part being inserted into the recess and closing or opening the injection nozzle depending on the position of the first part, wherein the second part is coupled to the

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actuator unit on one of its free ends (column 6, lines 23-33) and being coupled to the first part via a coupling unit comprising a coupling body (portion of first needle (13) below the dashed line including shim (23)), which is arranged in positive connection to the first part (via tubular sleeve) and joined (the second needle part and coupling unit are joined together to form one single unit and therefore the interpretation above where the second needle part being the portion of first needle (13) above the dashed line and the coupling unit being the portion of the first needle (13) below the dashed line from one integral piece, first needle (13)) wherein the coupling unit forms a spring rest (Shim (23) has spring (24) sitting on it), that urges the needle towards the position in which the injection nozzle is closed (column 5, lines 50-60).

The device further includes a receptance (enlarged region (20b)) formed in the first part and fixes a keeper (tubular sleeve (18)) in axial direction relative to the needle, and the coupling body having a recess (drilling (17)) through which the first part protrudes and which takes in the keeper such that the keeper fits substantially tightly within the recess to substantially prevent any radial movement of the keeper and first needle part relative to the second needle part [column 3, lines 41-43 & 54-56], the actuator (not shown), second needle part, and first needle part are arranged end-to-end in that order along an axial length of the fluid injector such that the movement of the actuator unit acts on the second part of the needle, which in turn acts on the first part of the needle to move the first part of the needle.

6. Claims 4, 8, & 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent #6,260,775 to Lambert et al.

The recited process of the coupling unit being joined to the second part by welding is a product by process recitation. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious variant

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from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113). Further, it is well known in the art to weld to pieces together in order to form one integral component. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to weld two pieces of material together in order to produce first needle (13) shown by Lambert, in order to allow the components internal to the system being coupled together to be more easily constructed.

Response to Arguments

7. Applicant's arguments with respect to claims 1-2, 4-6, & 8-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN JONAITIS whose telephone number is (571)270-5150. The examiner can normally be reached on Monday - Thurs 6:30am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on (571)272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JUSTIN JONAITIS/
Examiner, Art Unit 3752
05/13/2010

/Dinh Q Nguyen/
Primary Examiner, Art Unit 3752